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In re Application of	:
Jack E. Arbiser	:
Serial No.: 09/765,491	: PETITION DECISION
Filed: January 18, 2001	:
Attorney Docket No.: EU 98055	:

This is in response to the petition under 37 CFR 1.144, filed February 4, 2004, requesting withdrawal of an improper restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 on January 18, 2001, as a Continuation of SN 09/345,712 and contained claims 4-6 and 10-17 as amended by preliminary amendment. In a first Office action, mailed July 27, 2001, the examiner set forth a restriction requirement dividing the claims into two groups, as follows:

- Group I, claims 4-6, 10-12 and 17, drawn to a method of inhibiting skin disorders;
- Group II, claims 13-16, drawn to a pharmaceutical composition containing a curcumin.

The examiner set forth appropriate reasoning for dividing the claims,

Applicant replied on September 4, 2001, electing group I with traverse arguing that the method of use and the composition should be examined together and would not be a burden on the examiner to do so.

The examiner mailed a new Office action to applicant on November 21, 2001, acknowledging applicants election of Group I and responded to the traversal, but maintained the requirement. The examiner also set forth rejections for obvious double patenting, for indefiniteness under 35 U.S.C. 112, second paragraph, for anticipation under 35 U.S.C. 102(b) over Aggarwal et al and Andrulis, Jr., et al, and for obviousness under 35 U.S.C. 103(a) over JP 10120558, Aggarwal et al, applicant's admissions and Pharmacotherapy.

Applicant replied on March 21, 2003, amending claims 4, 10 and 17, canceling claims 13-16 and adding claim 18. Each of the rejections were addressed appropriately.

The examiner mailed a new non-Final Office action to applicant on August 13, 2002. The examiner presented a new rejection under 35 U.S.C. 112, second paragraph, for indefiniteness, and a new rejection under 35 U.S.C. 103(a) over Sukhatme, Doland's Medical Dictionary, Galardy and O'Reilly. Claims 10-12 and 18 were indicated as allowable.

Applicant replied on November 13, 2002, and amended claims 4, 6 and 17 and added claim 19, and responded to the rejections of record.

On February 12, 2003, the examiner mailed a new non-Final Office action to applicant requiring an election of species in claims 4, 10 and 17, stating that they are directed to a number of species which are independent and distinct from each other. No rejections were made and no claims indicated allowable.

Applicant replied on March 12, 2003, electing a curcuminoid as the species to be examined and traversed the requirement and in addition filed a petition to the Director to withdraw the requirement arguing primarily that it was too late in the prosecution to make such a requirement.

The examiner in the next Office action, mailed November 4, 2003, held claims 4-6 and 17 withdrawn from consideration and examined claims 10-12 and 18-19. The examiner responded to the traversal by maintaining the requirement on the basis that a restriction requirement may be made at any time during the prosecution of an application. The petition was dismissed as premature by the examiner. Claims 10-12 and 18 were rejected under 35 U.S.C. 103(a) as unpatentable over Galardy, AlAlousi et al (sic Alousi) and Arbiser et al in view of Thaloor et al. Claims 10, 12 and 19 were rejected under 35 U.S.C. 103(a) as unpatentable over Arbiser et al in view of Thaloor et al.

Applicants replied on February 4, 2004, by filing this petition and by filing an amendment on March 1, 2004. The amendment has not been considered by the examiner.

DISCUSSION

Applicant does not argue the initial restriction requirement between method and compositions and has acquiesced therein by canceling claims to the non-elected invention. Applicant, however, strenuously traverses the election of species requirement first set forth in the fourth Office action. Applicant argues that an election of species should be set forth in the first Office action. While this is not necessarily an absolute requirement, an election of species should be set forth as early as possible in the prosecution, not as here, after significant consideration on the merits has occurred.

Applicant also argues that the species on which the election of species is based have been in the claims with little change from filing and that at least two Office actions treated all of the species

on their merits. Since they were examined on their merits it would be improper to now divide them by requiring an election between them for examination purposes.

The examiner has argued in response to the above that a restriction requirement may be made at any time during prosecution. While this is not incorrect, an election of species requirement is not a true restriction requirement, but merely a tool an examiner can use in cooperation with an applicant to determine where a search and examination of an invention should begin. Restriction requires that the divided inventions be independent and distinct. Election of species requires only that they be independent of each other. They are not distinct in the usual sense since they are directed to the same category of invention (e.g. compounds, method of use of a compound, etc.). In view of the prosecution history of this application the examiner's election of species requirement was inappropriate since all species had, or should have, been considered and examined in the first Office action on the merits.

DECISION

The petition is **GRANTED**.

The application will be forwarded to the examiner for further consideration, including the amendment filed March 1, 2004, not inconsistent with this decision and withdrawal of the election of species requirement.

No fee is required for this petition and the petition fee paid of \$130.00 will be credited to applicant's Deposit Account No. 50-1868, as directed.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 703-872-9306.



Bruce M. Kisliuk
Director, Technology Center 1600